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IN THE

Supreme Court of the United States.

No.

OCTOBER TERM, 1954.

In the Matter of the Design Patent Application D-146,644 of HARRIS S. CAMPBELL.

HARRIS S. CAMPBELL, *Petitioner.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

PRAYER.

Your Petitioner, Harris S. Campbell, respectfully prays that a Writ of Certiorari issue to the United States Court of Customs and Patent Appeals to review the Judgment of that Court in Patent Appeal No. 6015.

The principal reason for this Petition is that a statutory benefit has been denied Petitioner through action taken by the Patent Office and sanctioned by the majority of the Court below which is in conflict with at least three sections of the patent statute and inconsistent with doctrines expressed in decisions of this Court as well as by the dissent in the Court below.

The case here is not a situation where a statutory benefit is to be allowed only in the discretion of the administering agency.

This is a situation where, under the precise state of facts, Congress has declared that a benefit should flow.

That benefit cannot be denied. *Dismuke v. United States,* 297 U. S. 167, 172; *United States v. Laughlin,* 249 U. S. 440, 443. The denial of the benefit has, in effect, amended certain sections of the patent statute. This is not permitted. *Pillsbury v. United Engr. Co.,* 342 U. S. 197, 199; *Colgate-Palmolive-Peet Co. v. N. L. R. B.,* 338 U. S. 355, 363.

Public policy demands as a primary function of an administrative agency the carrying out of the will of the Congress in a manner which is consistent with the applicable statutes.

The injustice of the denial of a statutory benefit to Petitioner was clearly and forcefully expressed in the dissenting Opinion of Judge O'Connell in the Court below

> ". . . appellant under the statutes was entitled *as a matter of right* to amend his pending application by filing the divisional application at bar . . ."[1]
>
> • • •
>
> "The present statute relating to divisional applications, 35 U. S. C. § 121, which in general paraphrases similar provisions in the old law, so far as pertinent, now reads:
>
> > '121. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. • • •'[2]

The patent statutes past and present have further provided that all the regulations and provisions which

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1. R. p. 52.
2. R. p. 53.

apply to obtaining or protecting other inventions or discoveries shall likewise apply to patents for designs."

• • •

"The Patent Office has here deprived appellant of a substantial property right by a process of reasoning which exploits the trivial and ignores that which is vital and important. The Supreme Court has recently reiterated the long established rule which governs here, namely, that ' "A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right." ' Hartford-Empire Co. v. United States, 323 U. S. 386, 433, citing Chapman v. Wintroath, 252 U. S. 126, at page 137."[3]

OPINIONS BELOW.

The majority and dissenting Opinions of the Court of Customs and Patent Appeals in said Patent Appeal No. 6015 are reported in 212 F. 2d 606. A Transcript of the Record including the majority and dissenting Opinions of that Court is furnished herewith in accordance with Rule 21-1 and Rule 23-1(i) of this Court.

JURISDICTION.

The majority and dissenting Opinions of the Court of Customs and Patent Appeals were filed April 9, 1954. A Petition for Rehearing was denied May 24, 1954. Judgment was entered June 3, 1954.

The jurisdiction of this Court is invoked under Section 1256 of the Judicial Code, as amended by the Act of June 25, 1948, c. 646, 62 stat. 928 (28 U. S. C. 1256).

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3. R. pp. 54, 55.

QUESTIONS PRESENTED.

1. Where an applicant files a patent application on a helicopter disclosing a pilot's control system for the machine and further disclosing the ornamental design of the machine, supported by an oath and filing fee, these components meeting the requirements of the statute pertaining to the contents of applications—is not the filing date accorded that application by statute effective as to *both* the design and the control system and hence, may not the applicant exercise his statutory right to amend the application by dividing out the design?

2. Where, according to statute, the scope of appellate jurisdiction of the Court of Customs and Patent Appeals is "confined to the points set forth in the reasons of appeal"—is it not inconsistent with the statute for that Court to rule against an appellant's claim upon a point not set forth in said reasons?

STATUTE INVOLVED.

The statute involved is Public Law 593, 82nd Cong., Chap. 950, 2nd sess., enacting as Section 1 thereof, Title 35 of the United States Code, entitled "Patents". The enabling section and the repealer section of Public Law 593, respectively Section 4 and Section 5, are set forth in an Appendix to this Petition. Also set forth in the Appendix are the most pertinent provisions of Title 35, United States Code: Section 41, Patent Fees; Section 111, Application for Patent; Section 115, Oath of Applicant; Section 120, Benefit of Earlier Filing Date in the United States; Section 132, Notice of Rejection; Reexamination; Section 144, Decision on Appeal; and Section 171, Patents for Designs. Inasmuch as the repealer section of said Public Law 593 does not affect any rights or liabilities existing under parts or sections of the Revised Statutes repealed, the pertinent sections of said Revised Statutes are also set forth in the Appendix.

STATEMENT OF THE CASE.

The jurisdiction of the Court of Customs and Patent Appeals was invoked under Section 4911, Revised Statutes, Aug. 5, 1939, ch. 451, sec. 3, 53 stat. 1212.

On July 30, 1946, the Petitioner filed in the United States Patent Office application Serial No. 687,115.[4] That application related to ROTATIVE WINGED AIRCRAFT and contained a petition, oath, filing fee, specification and drawings.[5] (For convenience, the word "helicopter" is herein used interchangeably with "rotative winged aircraft".) That application disclosed a pilot's control system for the rotors of the aircraft and, in addition, disclosed the ornamental design of the aircraft. On November 17, 1953, patent No. 2,659,551, entitled CONTROL SYSTEM FOR TANDEM ROTOR HELICOPTERS issued on said application with claims directed to the pilot's control system.

On May 28, 1948, while application Serial No. 687,115 was pending,[6] the Petitioner filed in the Patent Office application D-146,644 (now before the Court) as a division of application 687,115, this fact being noted by a statement in the specification and oath thereof.[7]

Application D-146,644 is directed to the ornamental design of the helicopter first disclosed in 687,115. It was stipulated, in the Court below, that the first two figures in application 687,115 "show the same device as that shown in Figures 1 and 2 of the instant case".[8]

Two references were cited by the Patent Examiner during the prosecution of the divisional application, namely: the design patent D-144,401 to P. M. Lewis, issued April 9, 1946, and the publication "American Helicopter", December, 1945, page 41.[9] The latter date, although more than

4. R. p. 37.
5. R. pp. 37, 38.
6. R. pp. 4, 5.
7. R. pp. 5, 6, 7.
8. R. p. 4.
9. R. p. 18.

one year prior to the filing date of Petitioner's divisional application, is less than one year prior to the filing date of his parent application 687,115; and accordingly, the Petitioner filed an Affidavit Under Rule 131 [10] to remove the "American Helicopter" publication as a reference.

Both the Patent Office and the Court below considered Petitioner's affidavit filed under Rule 131 "sufficient in substance" but not effective to remove the "American Helicopter" publication as a reference; [11] on the theory that the design application could not be based on the first application as a division thereof, and thus, was not entitled to the filing date thereof.[12] Thus, both the Board of Appeals and the Court used "American Helicopter" in denying Petitioner's claim.[13]

The fact is Petitioner made his design invention prior to the publication date of "American Helicopter". This is obviously the case, since the affidavit is conceded to be sufficient in substance. Yet, because he is being denied the benefit of the early filing date, the "American Helicopter" publication is being used to deprive him of protection on his design.

While it was not a point before it, the Court below also apparently ruled Petitioner's claim as lacking in invention over Lewis alone.[14]

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10. R. p. 4; for text of Rule 131 see Appendix.
11. R. pp. 16, 18, 48.
12. R. pp. 16, 23, 48.
13. R. pp. 22, 48.
14. R. p. 49.

ARGUMENT.

In the section entitled "PRAYER" appearing above, the principal reasons for the granting of this Petition are set forth. The basis for these reasons is set forth in (A) through (D) below.

(A) The Exercise of Administrative Power by the Patent Office and Sanctioned by the Court Below Is Inconsistent With the Section of the Patent Statute Relating to the Contents of an Application.

Section 111 of the new Patent Act states:

> "Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law."

All of the parts required for an application were contained in Petitioner's original application, 687,115.

The Disclosure.

Petitioner's parent application 687,115 included a specification and drawings, and it is an admitted fact that Figures 1 and 2 of that application showed the same device as that shown by the drawings of the divisional application.

There is no question whatsoever that the parent application made a full and a complete disclosure of the design. The statutory requirement was complied with.

Filing Fee.

Petitioner's parent application was accompanied by a fee of $31.00.[15] This amount is entirely adequate to cover

any of the design filing fees (three and one-half years, $10.00; seven years, $15.00; fourteen years, $30.00).

The requirement that an application be accompanied by the fee required by law was complied with.

Oath.

The Statute R. S. 4892, which dealt with oaths at the time the parent application was filed, made no substantive distinction between the material to be included in an oath for a mechanical application and material to be included in an oath for a design application.[16]

Nor does Section 115 of the new Patent Act make any such substantive distinction.

The oath in Petitioner's parent application met the statutory requirements and was entirely sufficient to support the design.

Summary of (A).

Neither the Patent Office nor the Court below has brought forth any facts or reasons as to why the disclosure, fee or oath of 687,115 were statutorily defective and, therefore, insufficient to support the design. The filing date accorded 687,115 should be effective as to the design and, therefore, the affidavit filed under Rule 131 effective to remove "American Helicopter" publication as a reference.

When Petitioner filed his parent application, he fully complied with the first stage in the ultimate bargain to be made with the Government.

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15. R. p. 4.

16. The designations "mechanical application" and "design application" are labels or terminology of the profession, just as are the terms "chemical application" and "process application". Indeed, in the proceedings below, the Petitioner's application 687,115 was referred to as a "hybrid application". Labels or terminology are not controlling on the issues here. Section 111 of the new Patent Act refers simply to "application for patent" without discrimination between them.

He made a complete disclosure (including the design), he paid the filing fee and he made an oath that he "verily believes himself to be the original, first and sole inventor".

It is inconceivable that the filing date accorded the 687,115 application does not apply to the design when the statutory requirements as to the contents of a patent application were fully met. The action below is inconsistent with the doctrine expressed in the case of *Manhattan General E. Co. v. Commissioner of Int. Rev.*, 297 U. S. 129, where this Court stated (at pages 134 and 135):

> "The power of an administrative officer or board to administer a federal statute and to prescribe rules and regulations to that end is not the power to make law, for no such power can be delegated by Congress, but the power to adopt regulations to carry into effect the will of Congress as expressed by the statute. A regulation which does not do this, but operates to create a rule out of harmony with the statute, is a mere nullity. Lynch v. Tilden Produce Co., 265 U. S. 315, 320-322, 44 S. Ct. 488, 68 L. Ed. 1034; Miller v. United States, 294 U. S. 435, 439, 440, 55 S. Ct. 440, 79 L. Ed. 977, and cases cited. And not only must a regulation, in order to be valid, be consistent with the statute, but it must be reasonable. International R. Co. v. Davidson, 257 U. S. 506, 514, 42 S. Ct. 179, 66 L. Ed. 341."

(B) The Action Taken by the Patent Office and Sanctioned by the Court Below Is in Conflict With the Section of the Patent Statute Which Gives a Right to Amend a Pending Application by Alteration of Its Specification or by the Filing of a Divisional Application.

At the time parent application 687,115 and the divisional application D-146,644 were first copending before the Patent Office, the right to amend was given by R. S. 4903 which reads in part:

> "Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant

> thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety *of renewing his application or of altering his specification* . . ." (Emphasis added.)

The right to amend a pending application is set out in Section 132 of the new patent act.

There can be no valid argument against the proposition that the foregoing creates a statutory right in an applicant to amend his application.

Amendment may be effected by alteration of a pending application or by the filing of a divisional application. A division is a matter of amendment. That proposition was christened, so to speak, in the decision of this Court in *Godfrey v. Eames,* 1 Wall. 317, 68 U. S. 684, where this Court stated (at pages 685-686):

> "The Act of July 4, 1836, gives the applicant a right to change his specification after receiving the suggestions of the commissioner. Doubtless, this right exists and may be exercised independently of such suggestions, at any time before the commissioner has given his formal judgment upon the application; and the inventor may 'persist in his application for a patent, with or without any alteration of his specification.' A change in the specification as filed in the first instance, *or the subsequent filing of a new one,* whereby a patent is still sought for the substance of the invention as originally claimed, or a part of it, cannot in any wise affect the sufficiency of the original application or the legal consequence, flowing from it . . ." (Emphasis added.)

That proposition was clearly and positively stated in *Dwight & Lloyd Sintering Co., Inc. v. Greenawalt,* 27 F. 2d 823 (CCA 2) wherein Judge Learned Hand said (at page 831):

"It is now settled law, in spite of any doubts that may have been cast upon it by certain observations in Chapman v. Wintroath, 252 U. S. 126, 40 S. Ct. 234, 64 L. Ed. 491, that *a divisional application is no more than an amendment in the parent application,* at least unless 'new matter' be introduced in the specification, which, whatever latitude it gives, was not the case here. Webster v. Splitdorf, 264 U. S. 463, 44 S. Ct. 342, 68 L. Ed. 792; American Co. v. Prosperity Co., 295 F. 819 (C. C. A. 2); Westinghouse v. Jeffrey, 22 F. (2d) 277 (C. C. A. 2); Wagenhorst v. Hydraulic Co. (C. C. A. 6) 27 F. (2d) 27. Obviously this must be true, if the division is to take its date from the original, as it does; it could not be a proliferation of that original, unless the latter already adequately disclosed it. Until divided, the parent must therefore be understood to contain all those inventions, no matter how many are later divided out of it. At least, until then its fate is theirs; it carries them in its bosom." (Emphasis added.)

Section 132 does not qualify the right to amend a pending application (except as to new matter). Nor did R. S. 4903 qualify the right to amend a pending application (except as to the time for presenting a claim for interference purposes).

There is no qualification as to the extensiveness of an amendment either to a single, some or all parts of an application.

Certainly there is no qualification that if some or all parts of the application are amended at the same time that this would constitute the filing of a new application and the original filing date be forfeited. On this point, the majority Opinion of the Court below stated:

"We are aware that it is not unusual to do any one or more of the previous cancellations and substitutions at some time during the prosecution of an application before the Patent Office. However, to do all

of the necessary cancellations and substitutions at the same time would be, in effect, the filing of a new application and not merely the amending of a previously filed application. . . ."[17]

This is a judicial qualification or amendment of a statutory right and is not permitted. *Pillsbury v. United Engr. Co., supra; Colgate Palmolive-Peet Co. v. NLRB, supra.*

The majority Opinion of the Court below, by failing to recognize Petitioner's design application as an amendment to his originally filed application 687,115, is directly inconsistent with Section 132 of the patent statute and further, is squarely inconsistent with the authorities mentioned above.

(C) The Exercise of Administrative Power by the Patent Office and Sanctioned by the Court Below Is in Conflict With the Section of the Patent Statute Relating to the Benefit of Earlier Filing Date in the United States.

Section 120 of the new Patent Act states:

"An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

In connection with Section 120, note that Section 171 says in part, "The provisions of this title relating to patents for inventions shall apply to patents for designs, *ex-*

17. R. p. 47.

cept as otherwise provided." (Emphasis added.) We find no exception with respect to divisional applications.

Thus, by statute there are three factors essential in order that the application D-146,644 be accorded the filing date of the original or parent application 687,115:

(a) filed while the parent is pending;

(b) disclose subject matter in common with the parent; and

(c) filed by the same inventor.

All of these factors are met. The parent application was filed on July 30, 1946, and issued on November 17, 1953, while the divisional application D-146,644 was filed on May 28, 1948. It is an admitted fact that Figures 1 and 2 of the drawings of the Petitioner's parent application show the same device as that shown by the drawings of the divisional application before the Court. The same inventor filed both applications.

It is maintained that there is absolutely no qualification in Section 120 which would prohibit the filing date of parent application 687,115 being effective as to divisional application D-146,644.

The Commissioner's Decisions in the cases of *Ex parte Waterman,* 1902 C. D. 235 and *McArthur v. Gilbert,* 1904 C. D. 245, are authorities relied upon by the Patent Office and also by the Court below for holding that Petitioner's application D-146,644 cannot have the benefit of the filing date of his parent application 687,115.

Had the Congress considered the rules or doctrines of the *Waterman* and *McArthur* cases as sound, a proviso could have been inserted in Section 120 to make these cases effective. This was not done.

The language of Section 120 is unambiguous and plain.

It must be assumed that the Congress rejected the *Waterman* and *McArthur* doctrines.

The action taken below is, therefore, squarely inconsistent with the provisions of Section 120.

(D) The Court Below Exceeded Its Jurisdiction in Apparently Rejecting Petitioner's Design as Lacking in Invention Over Lewis.

According to Section 144 of the new patent act defining the scope of review, the appellate jurisdiction of the Court of Customs and Patent Appeals is confined "to the points set forth in the reasons of appeal".

In ruling that the design lacked invention, the majority Opinion of the Court below said:

> ". . . The Board of Appeals affirmed the examiner's rejection on the prior art, but apparently combined the rear pylon of the Lewis helicopter with the basic design disclosed by the 'American Helicopter' reference . . ."[18]
>
> ". . . When viewed in the light of the prior art appellant's design appears to be a modification of the 'American Helicopter' reference, and as such is not entitled to the patent monopoly. In re Abrams et al., 40 C. C. P. A. (Patents), 1045, 205 F. 2d 202, 98 U. S. P. Q. 215; In re Johnson, 36 C. C. P. A. (Patents), 1175, 175 F. 2d 791, 82 U. S. P. Q. 199.
>
> Therefore, we are of the opinion that appellant's design, though different in some respects from the cited prior art, is well within the skill of a routine designer in the art and that the exercise of the inventive faculty was not required to produce the appealed design. See In re Jabour, 37 C. C. P. A. (Patents), 1084, 182 F. 2d 213, 86 U. S. P. Q. 98."[19]

It is clear that the Court—just as the Board of Appeals—was leaning heavily upon the "American Helicopter" reference, but the last quoted paragraph apparently implies that the design lacked invention over Lewis alone. If that

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18. R. p. 43.
19. R. p. 49.

was intended, then the Court exceeded its jurisdiction, for that point was not in Petitioner's reasons of appeal. This was because neither the Examiner nor the Board of Appeals rejected the design as lacking in invention over Lewis alone.

CONCLUSION.

The Petitioner has been arbitrarily deprived of his clear statutory right to his early filing date for the benefit of his divisional case. The dissenting Opinion below points out that this deprivation was "by a process of reasoning which exploits the trivial and ignores that which is vital and important . . . These are questions not of natural but of purely statutory right."[20]

For the reasons expressed herein and so forcefully stated in the dissenting Opinion of Judge O'Connell in the Court below, it is earnestly submitted that this Petition should be granted.

Respectfully submitted,

HARVEY L. LECHNER,
Counsel for Petitioner.

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20. R. p. 54.

APPENDIX.

Pertinent Sections of Statute Involved.

A. Public Law 593, 82nd Congress, Chapter 950, Second Session, "AN ACT to revise and codify the laws relating to patents and the Patent Office and to enact into law Title 35 of the United States Code entitled 'Patents'" (all 66 Stat. 792-817). [Sections 1, 2, 3 and parts of Sections 4 and 5 omitted.]

"SEC. 4. (a) This Act shall take effect on January 1, 1953, and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided."

[Paragraphs (b) through (h) omitted.]

"SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal."

[Schedule of repealed statutes omitted.]

B. Pertinent sections of Title 35, United States Code, Section 1, as enacted by Public Law 593 and corresponding pertinent sections of the Revised Statutes (repealed by Section 5 of Public Law 593).

"§ 41. Patent fees

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30."

"R. S. 4934. Patent fees (July 5, 1946, ch. 541, sec. 301, 60 Stat. 471)

In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30."

• • •

"§ 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law."

"R. S. 4888. Application for patent; description; specification and claim (May 23, 1930, ch. 312 sec. 2, 46 Stat. 376)

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected,

to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

* * *

"§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him."

"R. S. 4892. Same; oath of applicant (May 23, 1930, ch. 312, sec. 3, 46 Stat. 376)

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, or consul holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States."

* * *

"§ 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

* * *

"§ 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention."

"R. S. 4903. Notice of rejection of claim; copying claim of patent (Aug. 5, 1939, ch. 452, sec. 1, 53 Stat. 1213.)

Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the commissioner shall order a reexamination of the case.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted."

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"§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

• • •

"§ 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

"R. S. 4929, 4933. Patents for designs; how obtained; regulations applicable (Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212)

Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 31 of this title, obtain a patent therefor.

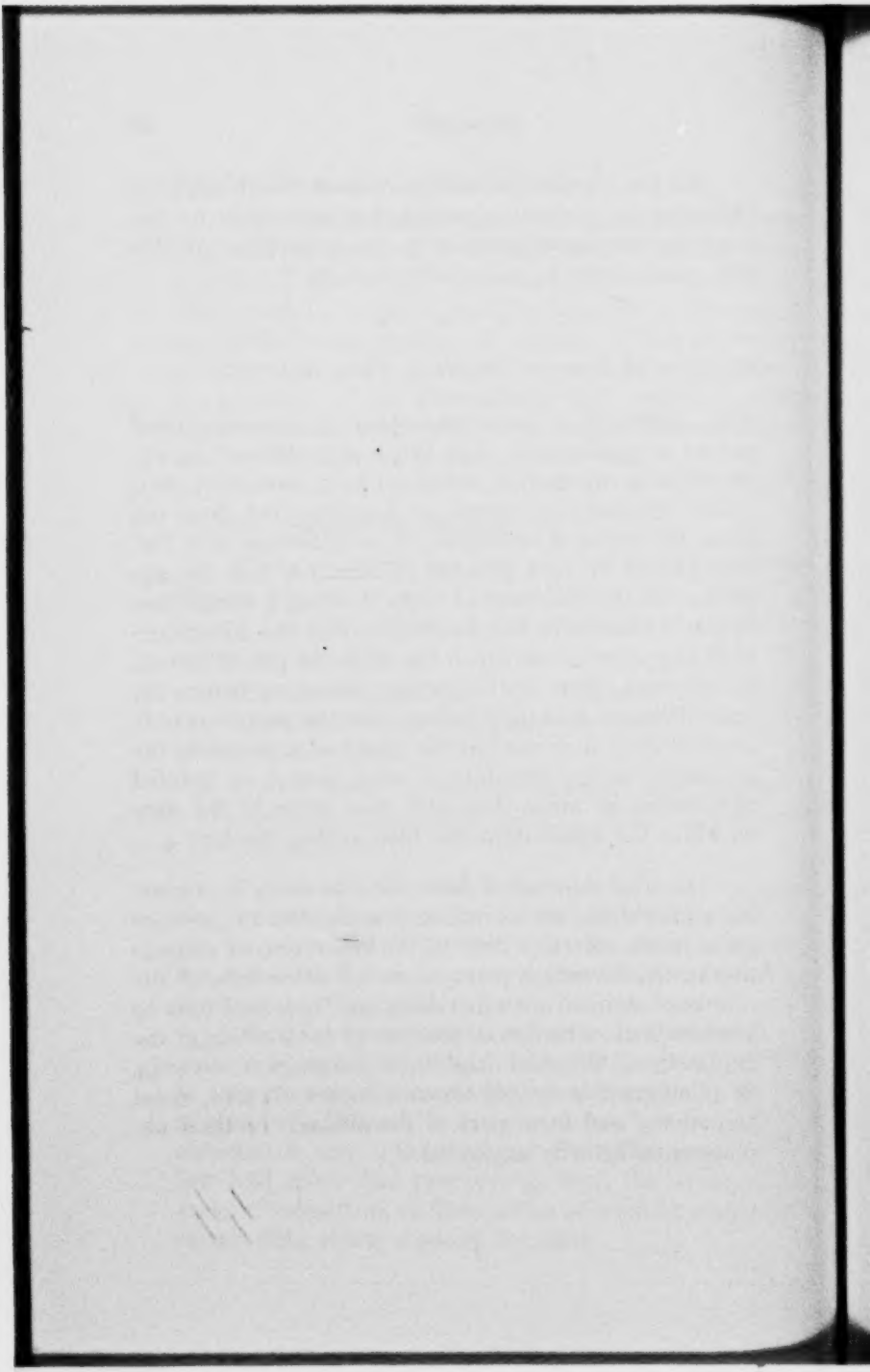
All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs."

* * *

C. Rules of Practice, March 1, 1949, Rule 131.

"131. *Affidavit of prior invention to overcome cited patent or publication.* (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photographic or photostatic copies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained."



APPENDIX "B"

[fol. 40] THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1953

Patent Appeal No. 6051

Patent Calendar No. 37

Serial No. D-146,644

IN THE MATTER OF THE APPLICATION OF HARRIS S. CAMPBELL.

OPINION—April 9th, 1954

JOHNSON, Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the action of the Primary Examiner in finally rejecting the single claim in appellant's application, Serial No. D-146,644. for a design patent on "Rotative Winged Aircraft." The claim was rejected for lack of invention over the prior art.

The appealed claim reads as follows:

> The ornamental design for rotative winged aircraft substantially as shown.

The references relied on are:

Lewis	Des. 144,401	April 9, 1946
"American Helicopter,"	page 41	December 1945

Appellant's application was filed May 28, 1948, and discloses a helicopter having tandem three-blade rotors, the blades of which overlap. The fuselage is generally tear-shaped in both side and top view, being slightly non-symmetrical in the side view, with a non-symmetrical blunt nose which bulges outwardly in the lower half. The aft portion of the fuselage, in side view, bends upwardly into [fol. 41] a large rear pylon, shaped similar to a conventional vertical stabilizer, which supports the rear rotor

above the forward rotor. In top view the fuselage has a blunt nose that converges to a relatively sharp tail, with a portion of the sides substantially parallel for approximately two-thirds of their length. Three landing wheels are provided, two forward wheels which extend downwardly and outwardly at an angle from the fuselage, and a tail wheel directly under the aft end of the fuselage. A small forward pylon is provided for the front rotor, with its top positioned well below the top of the rear pylon. Both pylons are egg-shaped in cross-section, with the smaller end positioned in a rearward direction. Windows are provided in the nose, above the protuding portion.

The Lewis patent discloses a design for a helicopter, provided with three two-blade rotors, two of said rotors positioned along the forward part of the fuselage on arms projecting to either side thereof, and one disposed in the aft portion, atop a pylon which is shaped like a conventional vertical stabilizer. The fuselage is generally tear-shaped, in both top and side view, with its nose portion less blunt than appellant's design, and the sides being bowed outward in the center, converging to a relatively sharp tail. Three landing wheels are provided, two at the forward portion of the fuselage, mounted on short, streamlined arms extending on either side, and a tail wheel directly under [fol. 42] the aft portion of the fuselage. The forward rotor supports are generally tear-shaped, with the sharp portion positioned in a rearward direction.

The "American Helicopter" reference discloses a helicopter having tandem, three-blade rotors, the blades of which overlap. The views shown are a close-up, phantom, perspective view and a background view of a helicopter in flight. The fuselage appears to be generally tear-shaped in both top and side views, with the center portion bowed outwardly. The blunt nose appears symmetrical and is almost completely enclosed by windows. The rearward rotor is mounted on a pylon raised above the pylon which mounts the forward rotor so that the blades of the rear rotor pass well above those of the forward rotor. The rear pylon is generally triangular shaped with the fuselage coming to a relatively sharp point to the rear thereof, to provide an

exhaust for a jet engine. The landing wheels are retractable, two forward wheels extending downwardly and outwardly from the fuselage through opening therein provided with hinged covers, and a pair of tail wheels directly under the aft portion of the fuselage, which can be retracted within the fuselage and enclosed by a hinged cover. The pylons in this reference are of substantially the same thickness in cross section.

The examiner rejected appellant's design as being unpatentable over either of the above references. The Board [fol. 43] of Appeals affirmed the examiner's rejection on the prior art, but apparently combined the rear pylon of the Lewis helicopter with the basic design disclosed by the "American Helicopter" reference. In its decision the Board stated, in part as follows:

> The aircraft shown in the "American Helicopter" publication is quite similar in appearance to appellant's design. * * *. The forward rotor of the reference device is mounted on a support that extends somewhat higher above the top of the fuselage than appellant's turret-like front rotor support and the rear rotor is mounted on a generally triangular pylon, whereas appellant's rear rotor is mounted on a pylon that resembles a conventional vertical stabilizer. The Lewis patent, however, shows a three rotor aircraft in which the rear rotor is shown in Fig. 1 to be mounted at a higher level than the forward rotors on a vertical projection which resembles quite closely the appearance of appellant's rear rotor support.

Appellant contends that there are many differences between the references and his design and that these differences make the overall appearance of his design substantially distinguish over the references. It is also contended by appellant that the "American Helicopter" publication should be removed as a reference in view of his affidavit under Rule 131 of the Rule of Practice, swearing back of the publication date of that reference. The Patent Office concedes that appellant's affidavit is sufficient in substance to remove the reference, but holds that he can-

not swear back of the reference since it was published more than one year prior to his filing date. [35 U. S. C. (1952) § 102 (b)]

[fol. 44] However, appellant asserts that his design application is a division of his earlier filed application, Serial No. 687,115, for a mechanical patent on improvements in rotative winged aircraft. Both the Oath and Specification, as filed in the instant application, include a statement that such application is a division of the above mentioned application, Serial No. 687,115, filed July 30, 1946. It is also stipulated in the record of this case that Figures 1 and 2 of the earlier application show the same device as that shown by the drawings of the instant application. On this basis, appellant argues that he is entitled to the date of July 1946 for his design application, and since this is less than a year from the publication date of the "American Helicopter" reference his affidavit should be considered as removing that reference.

During the prosecution of this case the examiner consistently refused to acknowledge the design as a proper division of the earlier filed mechanical application and held that appellant was not entitled to the date of the earlier application for his design application. In support of this position the examiner cited the Commissioner's Decisions in the cases of *Ex Parte Waterman,* 1902 C. D. 235 and *McArthur* v. *Gilbert,* 1904 C. D. 245. The *Waterman* case held that a mechanical application could not be a division of an earlier filed design application, even though the design [fol. 45] application had completely disclosed the mechanical invention and had included claims thereto. In that case the earlier application had requested a patent for the term of 14 years and included the correct fee for such a design patent. The examiner refused the mechanical claims as improper subject matter for a design and the application was then limited to the design by amendment. When the applicant later filed a mechanical application he was refused the date of the earlier application on his claim of a divisional application. In the *McArthur* case, McArthur filed a mechanical application and later a design application. When an interference was declared on the design application McArthur tried to claim that the design was a division of the

earlier mechanical application, so as to make him the senior party in the interference. This claim was refused, and on appeal to the Commissioner of Patents the ruling was affirmed. The Commissioner held that the mechanical application was not a constructive reduction to practice of the design since the design could not have been claimed in the mechanical application.

The Board of Appeals affirmed the examiner in this view, despite appellant's arguments that the doctrine of the cited cases is erroneous. It was and is appellant's argument that when he filed his complete application in the Patent Office, disclosing both the mechanical invention and [fol. 46] the alleged design invention, that he could have amended his application to claim only the design disclosed therein, instead of the mechanical invention.

The question of a design application being a division of a mechanical application has apparently never been before the courts. We have searched diligently for a case on the point but have been unable to discover a single court decision on the subject. However, we do not think that there is any great difficulty in arriving at a proper solution. When appellant filed his earlier application his Petition requested that Letters Patent be granted him for his invention and paid the usual thirty dollar filing fee, plus an extra dollar, presumably for an additional claim. His specification described the invention in such "full, clear, concise, and exact terms as to enable any person skilled in the art" to make and use the same, as required by R. S. 4888, then in effect. The oath filed with the application was also the usual oath required in mechanical applications. It appears obvious to us that this was the usual type of mechanical application that disclosed an alleged improvement in rotative winged aircraft, such improvement being distinctly claimed in the claims submitted with the application. Clearly, if there was any "new, original, and ornamental design" invention disclosed in such application it could not be claimed therein. [fol. 47] Nor do we think that the application could have been amended to correspond to a design application. In order to so amend it would be necessary to amend the petition, to completely delete the specification originally filed, with the possible exception of the description of the first

two figures, and file the usual form of design specification, cancel all of the mechanical claims and substitute the usual formal design claim, cancel the original oath and substitute the usual design oath, and of course cancel all of the drawings with the exception of Figures 1 and 2.

We are aware that it is not unusual to do any one or more of the previous cancellations and substitutions at some time during the prosecution of an application before the Patent Office. However, to do all of the necessary cancellations and substitutions at the same time would be, in effect, the filing of a new application and not merely the amending of a previously filed application. And such new application would not, in our opinion be a continuation or division of the first, but an application for an alleged invention not previously disclosed in the earlier application. We do not believe that the filing in the Patent Office of drawings, which may show an alleged design invention, in the usual mechanical application can be considered a constructive reduction to practice of the alleged design invention.

[fol. 48] In the case of *Dieterich* v. *Leaf*, 24 C.C.P.A. (Patents) 1138, 89 F. (2d) 226, 33 USPQ 237, we held that the mere paper drawing of an alleged inventive design for a three-dimensional article could not constitute actual reduction to practice of the design. Since the drawing, *per se*, could not constitute an actual reduction to practice, we think it follows that the filing of the drawings, without the necessary complete parts of a design application, could not constitute constructive reduction to practice of the alleged design invention. Therefore, we must agree with the tribunals of the Patent Office that the affidavit under Rule 131, while sufficient in substance, could not remove the "American Helicopter" reference since the application was filed more than one year after the publication date of that reference, and the application was not entitled to the filing date of the earlier filed mechanical application.

Coming to the question of patentable distinction of appellant's design over the cited art, we do not thing it necessary to discuss all of the arguments raised by appellant. They are mainly limited to pointing out the many minor differences between his design and that of either the "American

Helicoptor'' or the Lewis reference. However, it is well settled that when considering the patentability of a design it is the appearance as a whole which must be considered, and the mere fact that there are differences over the [fol. 49] prior art structures is not sufficient to justify a holding that invention was required in the production of the design. *In re Bonnell,* 29 C.C.P.A. (Patents) 1104, 129 F. (2d) 520, 54 USPQ 202. Of course, appellant argues that the differences relied on for patentability are not minor differences, but rather are marked and striking differences. With this view we are unable to agree. It is readily apparent that there are some differences, but these do not, in our opinion, vary so greatly from the cited prior art as to create the impression of a new and different design. When viewed in the light of the prior art, appellant's design appears to be a modification of the ''American Helicopter'' reference, and as such is not entitled to the patent monopoly. *In re Abrams et al.,* 40 C.C.P.A. (Patents) 1045, 205 F. (2d) 202, 98 USPQ 215; *in re Johnson,* 36 C.C.P.A. (Patents) 1175, 175 F. (2d) 791, 82 USPQ 199.

Therefore, we are of the opinion that appellant's design, though different in some respects from the cited prior art, is well within the skill of a routine designer in the art and that the exercise of the inventive faculty was not required to produce the appealed design. See *In re Jabour,* 37 C.C.P.A (Patents) 1084, 182 F. (2d) 213, 86 USPQ 98.

[fol. 50] We have carefully reviewed all of appellant's arguments and all of the cases cited by appellant in favor of those arguments. However, we find nothing in the cases that is contrary to what we have stated, nor any authority to support a different conclusion. For the reasons hereinbefore stated the decision of the Board of Appeals is affirmed.

AFFIRMED.

Jackson, Judge, Retired, sat for Garrett, Chief Judge.

[fol. 51] UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1953, Patent Appeal No. 6015, Patent Calendar No. 37, Serial No. D-146,644

In the Matter of the Application of HARRIS S. CAMPBELL.

O'CONNELL, Judge, dissenting.

The Solicitor for the Patent Office properly concedes in his brief that if the application at bar is a true division of appellant's parent application, No. 687,115, his affidavit under Rule 131 effectively removes the reference "American Helicopter" from the proceeding.

That reference was evidently relied upon by the tribunals of the Patent Office to bolster their rejection of appellant's claim solely on the ground that it was unpatentable over the design disclosed by the patent to Lewis.

It is my conviction after a careful analysis of the facts presented by the record and the long array of effective authorities presented by counsel for appellant that "American Helicopter" is not a valid reference in this case and that the design defined by the rejected claim at bar is patentably distinct over the patent to Lewis.

[fol. 52] Appellant's drawings, in addition to showing certain mechanical features, fully disclosed the ornamental design of his helicopter. The board took the position that design and utility patents are authorized by different patent statutes, which extend patent protection for different periods of time, and if both types are disclosed in a single parent application, one cannot be divided out from the other and separately prosecuted in the Patent Office.

In that respect the tribunals of the Patent Office were in error since appellant under the statutes was entitled *as a matter of right* to amend his pending application by filing the divisional application at bar. *In re Febrey,* 30 CCPA 1099, 135 F 2d 751, 57 USPQ 407; *Harder et al.* v. *Hayward,* 32 CCPA 1051, 150 F. 2d 256, 66 USPQ 51; *Ex parte Hall,* 1920 C. D. 56. A divisional application is no more than an authorized amendment of a parent application, providing no new matter is thereby introduced into the disclosure of the claimed invention, *Godfrey* v. *Eames,*

1 Wall. 317, 68 U.S. 684; *Dwight & Lloyd Sintering Co.* v. *Greenawalt,* 27 F. 2d 823, 831; 35 U.S.C. 132. Such is not the case here inasmuch as it has been stipulated by counsel for the respective parties:

> That Figures 1 and 2 of the drawings in applicant's application Serial No. 687,115 filed July 30, 1946, and still pending in the Patent Office show the same device as that shown in Figures 1 and 2 of the instant case.

[fol. 53] The present statue relating to divisional applications, 35 U.S.C. 121, which in general paraphrases similar provisions in the old law, so far as pertinent, now reads:

> 121. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. * * *

The patent statutes past and present have further provided that all the regulations and provisions which apply to obtaining or protecting other inventions or discoveries shall likewise apply to patents for designs.[2]

The Solicitor for the Patent Office states his position and that of the Patent Office with respect to the controlling question of procedure here in issue:

> The common guiding factor, both in the decisions refusing to permit amendment of the application[3] * * * and those permitting amendment[4] * * * was the apparent intent of the applicant *at the time of filing.* Nothing in the law or in any of the decisions suggests any right in an applicant to change the essential character of an application once filed. (Italics quoted.)

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[2] R.S. 4929, 4933; 35 U.S.C., 1946 ed., 73; 35 U.S.C. 171.

[3] *Ex parte Sellers,* 1870 C.D. 58.

[4] *Ex parte Saunders, Jr.,* 1907 C.D. 363, 131 O.G. 1164.

There is no merit whatever in the position thus relied upon by the Patent Office. The identical point was advanced in *Harder et al.* v. *Hayward,* 32 CCPA 1051, 1073, 150 F. 2d 256, 66 USPQ 51, to the following effect:

> [fol. 54] In the case at bar, appellee, in filing his second [divisional] application * * * offered no reason whatever why the claims embraced in his second application were not presented in his original application. As pointed out by appellants, so far as the record shows, Hayward's added improvement in his second application may have been in Hayward's possession since before he filed his first application, and was omitted for reasons best known to himself; or it may have been an improvement conceived as an afterthought, such as either he or anyone else could have made after the filing of his original application.

The court concluded however that under the patent statutes the applicant was entitled to file his divisional application as a matter of right, and the views described in the excerpt quoted above were rejected by the majority as an unwarranted heresy. That ruling is applicable to the arguments now advanced by the Solicitor for the Patent Office.

The Patent Office has here deprived appellant of a substantial property right by a process of reasoning which exploits the trivial and ignores that which is vital and important. The Supreme Court has recently reiterated the long established rule which governs here, namely, that "A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right." *Hartford-Empire Co.* [fol. 55] v. *United States,* 323 U. S. 386, 433, citing *Chapman* v. *Wintroath,* 252 U. S. 126, at 137.

Appellant's divisional application in issue is a continuing copending application as defined by the authorities hereinbefore cited. It is well settled law, as we emphatically pointed out in *Teter* v. *Kearby,* 36 CCPA 706, 169 F. 2d 808, 79 USPQ 65, that "Where one invention which is clearly

disclosed in an application is not there claimed, but is subsequently claimed in a co-pending application by the same applicant, the first filing will be deemed a constructive reduction to practice and the later application will be given the filing date of the earlier one. *Chapman et al.* v. *Wintroath,* 252 U. S. 126." Furthermore, as we held in *Teter,* "It is immaterial that the subject matter in the last continuing case is claimed for the first time and that no previous claim was made of the subject matter in the earlier filed case. *Benedict* v. *Menninger,* 20 C.C.P.A. (Patents) 1138, 64 F. (2d) 1001, 17 U.S.Pat.Q. 499 and *Harold D. Arnold* v. *Irving Langmuir,* 17 C.C.P.A. (Patents) 756, 36 F. (2d) 834, 4 U.S.Pat.Q. 114."

Appellant's procedure in the case at bar may not have been in strict compliance with the general routine of the Patent Office. No disruption thereof has been established, however, and no valid reason given as required by law, [fol. 56] for the rejection of the appealed claim on what appears to be purely theoretical grounds. *International Standard Electric Corp.* v. *Kingsland,* 83 App. D.C. 355, 169 F. 2d 890.

For the reasons stated, the decision of the Board of Appeals should be reversed.

[fols. 57-64] APPENDIX "C"

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Friday, April 9, 1954

At a session of said court continued and held at the city of Washington, pursuant to adjournment, on this 9th day of April, A. D., 1954.

Present the Honorables Ambrose O'Connell, Noble J. Johnson, Eugene Worley, and William P. Cole, Jr., Associate Judges, and Honorable Joseph R. Jackson, Associate Judge, Retired.

The court was opened for business in due form.

* * * * * * *

In the matter of the Application
of Patent Appeal No. 6015.
Harris S. Campbell.

Subject Matter: Design for rotative winged aircraft.
Serial No. D-146,644.

Said appeal having heretofore been brought on to be heard before the court and due consideration thereon having been had, it is—

Ordered that the decision of the Board of Appeals be, and the same is hereby, affirmed.

* * * * * * *

[fol. 65] APPENDIX "D"

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Monday, May 24, 1954

At a session of said court continued and held at the city of Washington, pursuant to adjournment, on this 24th day of May, A. D., 1954.

Present the Honorables Ambrose O'Connell, Noble J. Johnson, Eugene Worley, and William P. Cole, Jr., Associate Judges, and Honorable Joseph R. Jackson, Associate Judge, Retired.

The court was opened for business in due form.

* * * * * * *

Patent Appeal No. 6015

In the Matter of the Application of Harris S. Campbell.

Appellant having duly filed petition for rehearing herein and due consideration thereon having been had, it is—

Ordered that said petition be, and the same is hereby, denied.

* * * * * * *

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In the Supreme Court of the United States

OCTOBER TERM, 1954

No. 300

HARRIS S. CAMPBELL, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. 25-31; R. 40-56) is reported at 212 F. 2d 606.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was entered on April 9, 1954 (R. 57). A petition for rehearing was denied on May 24, 1954 (R. 65). The petition for a writ of certiorari was filed on August 23, 1954. Petitioner attempts

to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 3).

QUESTION PRESENTED

Whether this Court has jurisdiction to review a decision of the United States Court of Customs and Patent Appeals, which affirmed the refusal of the Board of Appeals of the United States Patent Office to grant petitioner a design patent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra* pp. 9-10.

STATEMENT

The petitioner's application for a patent on his design for a helicopter was rejected for lack of novelty on reference to the combined effect of an earlier application by one Lewis, filed April 9, 1946 (R. 33-34), and an illustration in the periodical "American Helicopter" (R. 35). Rule 131 of the Rules of Practice in Patent Cases, United States Patent Office,[1] provides that references of the latter type shall not bar the grant of a patent if the applicant under oath states facts to show that he had completed his invention before the date of publication, and if his application was filed not more than a year after that date.

The petitioner filed the required affidavit (R. 4), and the critical question was that of the effective date of his application. He had filed an applica-

[1] Promulgated March 1, 1949, under the authority of the Commissioner of Patents to "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office." 35 U.S.C. 6.

tion for a patent on "his invention in Rotative Winged Aircraft" on July 30, 1946, with drawings showing a helicopter with a new system of controlling the rotors[2] (R. 37-38). While this application was pending, he filed the application now in dispute on May 28, 1948, for a design patent (R. 5-11); the drawings showed a helicopter of the same design as that in the first application, and the petitioner stated that this was a division of that application. Under the statute, an application based on the division of an earlier application is to be given the same effect as though filed at the earlier date. 35 U.S.C. 120.

Thus if the division was proper, the illustration from "American Helicopter" could not be a bar, since the first application was made within a year after that picture was published. But if the division was improper, and the design application had to be considered as a new one, the affidavit failed, and the illustration could be admitted. The examiners (R. 13, 14-17), the Board of Appeals (R. 18-25, 25-27), and the Court of Customs and Patent Appeals (R. 40-56) each held that an application for a mechanical patent cannot be later divided to serve as an application for a patent on a design disclosed therein.

ARGUMENT

This case was one of first impression below, and raised the important question whether an application ostensibly for a mechanical patent may be later

[2] Patent No. 2,659,551 was granted for this system on November 17, 1953, and is not in dispute.

divided so that an application for a patent on a design incidentally disclosed therein may be treated as having been filed on the same date. This issue has now been consistently resolved, however, in decisions at three successive levels by persons and judges having peculiar expertise in the field of patent law and procedures, and we believe that no further review is warranted. However this may be, the disposition of this petition is controlled, we submit, by the long-standing position of this Court that it is without jurisdiction to review summary appeals taken under R.S. 4914 (now 35 U.S.C. (1952 ed.) 144) from Patent Office determinations.

That the nature of these proceedings is such as to preclude recourse to this Court was established in *Postum Cereal Company* v. *California Fig Nut Company,* 272 U.S. 693.[3] In that case the Court stated (pp. 698-699) that what it was asked to review "is not a judicial judgment. It is a mere administrative decision. It is merely an instruction to the Commissioner of Patents by a court which is made part of the machinery of the Patent Office for administrative purposes. In the exercise of such function it does not enter a judgment binding parties in a case as the term case is used in the third

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[3] This Court had formerly held that it was unable to review such decisions on the ground that they were not final judgments within the meaning of the Act (27 Stat. 434, 436) granting it authority to review "final judgments" of the Court of Appeals for the District of Columbia. *Baldwin Company* v. *Howard Company,* 256 U.S. 35; *Gaines* v. *Knecht,* 212 U.S. 561; *Atkins and Company* v. *Moore,* 212 U.S. 285; *Frasch* v. *Moore,* 211 U.S. 1.

article of the Constitution." The Court emphasized that an interested person was not precluded "from having the right to contest the validity of such patent or trade-mark in any court where it may be called in question."

In 1927, the method of reviewing Patent Office determinations was changed by Congress to require the disappointed applicant to elect between a summary appeal to the Court of Appeals of the District of Columbia [4] and a bill in equity against the Commissioner of Patents in the Supreme Court of the District of Columbia (now the United States District Court for the District of Columbia),[5] whereas before that time the equity proceeding had been open even after an adverse decision in the summary proceeding in the appellate court.[6] Nonetheless, the nature of the summary proceeding was not changed, and this Court continued to refuse to assume jurisdiction over summary appeals in both patent and trade-mark cases. *Pacific Northwest Canning Co.* v. *Skookum Packers' Association,* 283 U.S. 858 (a trade-mark case), *McBride* v. *Teeple,* 311 U.S. 649 (a patent case).[7]

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[4] The forum for summary appeals was changed to the Court of Customs and Patent Appeals in 1929. 45 Stat. 1476, now 35 U.S.C. 141.

[5] 44 Stat. 1336-37, now 35 U.S.C. 145.

[6] R. S. 4915.

[7] In addition to these cases in which the Court expressly placed its refusal on jurisdictional grounds, it denied certiorari without comment in the following cases involving summary appeals from the Patent Office: *Panhard Oil Corp.* v. *Societe Anonyme,* 282 U.S. 858; *I. G. Farbenindustrie* v. *Lacy,* 282 U.S. 870; *Fessenden* v. *Wilson,* 284 U.S. 640; *Laughlin* v. *Robertson,* 284 U. S. 652; *United States Gypsum Co.* v. *Plas-*

Between the time that Congress transferred the jurisdiction over summary appeals to the Court of Customs and Patent Appeals and the time that Title 28, U.S.C. was codified in 1948, this Court had lacked express statutory authority, as well as constitutional power, to review patent and trademark cases from that tribunal, and this absence was noted in the brief statement accompanying the denial of the petition in the *Skookum* case, *supra.* In codifying Title 28, U.S.C., however, Congress provided in Section 1256 that

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari,

and it is on this section that petitioner posits the jurisdiction of this Court. The short answer is, of course, that the basis of the *Postum Cereal Company* opinion is a constitutional disability on the part of the Congress to confer jurisdiction which this Court is unable, under the Constitution, to assume. In any event, Congress manifested no intention to confer such jurisdiction on this Court in enacting Section 1256. The codification of Title 28, so far as Section 1256 is concerned, resulted merely in a division of Section 195 of the Judicial Code of 1911 (36 Stat. 1087, 1145), as amended (28 U.S.C. (1946 ed.) 308), which had theretofore

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toid Products, Inc., 284 U.S. 635; *Keller, Heumann & Thompson Co.* v. *Coe*, 298 U.S. 656; *Chase* v. *Avery*, 307 U.S. 638 (cited together with *Fessenden* v. *Wilson*, and the *Postum* and *Skookum* decisions in *McBride* v. *Teeple*), *Galena Manufacturing Co.* v. *Superior Oil Works*, 308 U.S. 609; *A. J. McPartland, Inc.* v. *Montgomery Ward & Co.*, 333 U.S. 875.

vested jurisdiction in the Court of Customs and Patent Appeals to review decisions of the Customs Court and had empowered this Court to review such decisions by writ of certiorari. In order to fit the organizational scheme of the new Title 28, the part of Section 195 governing the review of Customs Court decisions by the Court of Customs and Patent Appeals was placed in Section 1541 and the part that had conferred upon this Court power to review such decisions was placed separately in Section 1256. This is borne out by the Reviser's Note, and we have found nothing in the legislative history of this provision to indicate any Congressional intention to attempt to supply the lack of jurisdiction in this Court.[8]

There has been one further change in the applicable law since Title 28, U.S.C. was codified in 1948. In codifying Title 35 U.S.C. in 1952, Congress left out of the section governing summary appeals in patent cases in the Court of Customs and Patent Appeals (35 U.S.C. (1952 ed.) 144) the following language which had theretofore appeared in R.S. 4914, as amended (35 U.S.C. (1946 ed.) 62):

> * * * But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the valid-

[8] While this Court has not spoken on the subject since the enactment of the Judicial Code of 1948, it has denied petitions for certiorari in four cases in which jurisdictional grounds alone were pressed as reasons for opposing the granting of the writ. *Dalton et al.* v. *Marzall*, 342 U. S. 818; *Thompson* v. *Learned*, 342 U. S. 942; *Shackell* v. *Marzall*, 343 U. S. 978; *Martin* v. *Commissioner of Patents*, 344 U. S. 824.

> ity of such patent in any court wherein the same may be called in question.

This omission was not intended to alter the law in any respect, however. The committee reports state that the sections governing review of Patent Office action make "no fundamental change" in existing procedures, Senate Report No. 1979, p. 7, House Report No. 1923, p. 8, 82d Cong., 2d Sess., and the Reviser's Notes indicate that the provision was "omitted as superfluous."

Thus that same condition which led this Court to its result in the *Postum* case still obtains, and precludes the granting of the petition in the instant case.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied for want of jurisdiction.

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SEPTEMBER, 1954.

APPENDIX

The pertinent sections of Title 35 of the United States Code are as follows:

§ 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

* * * * *

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and

determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

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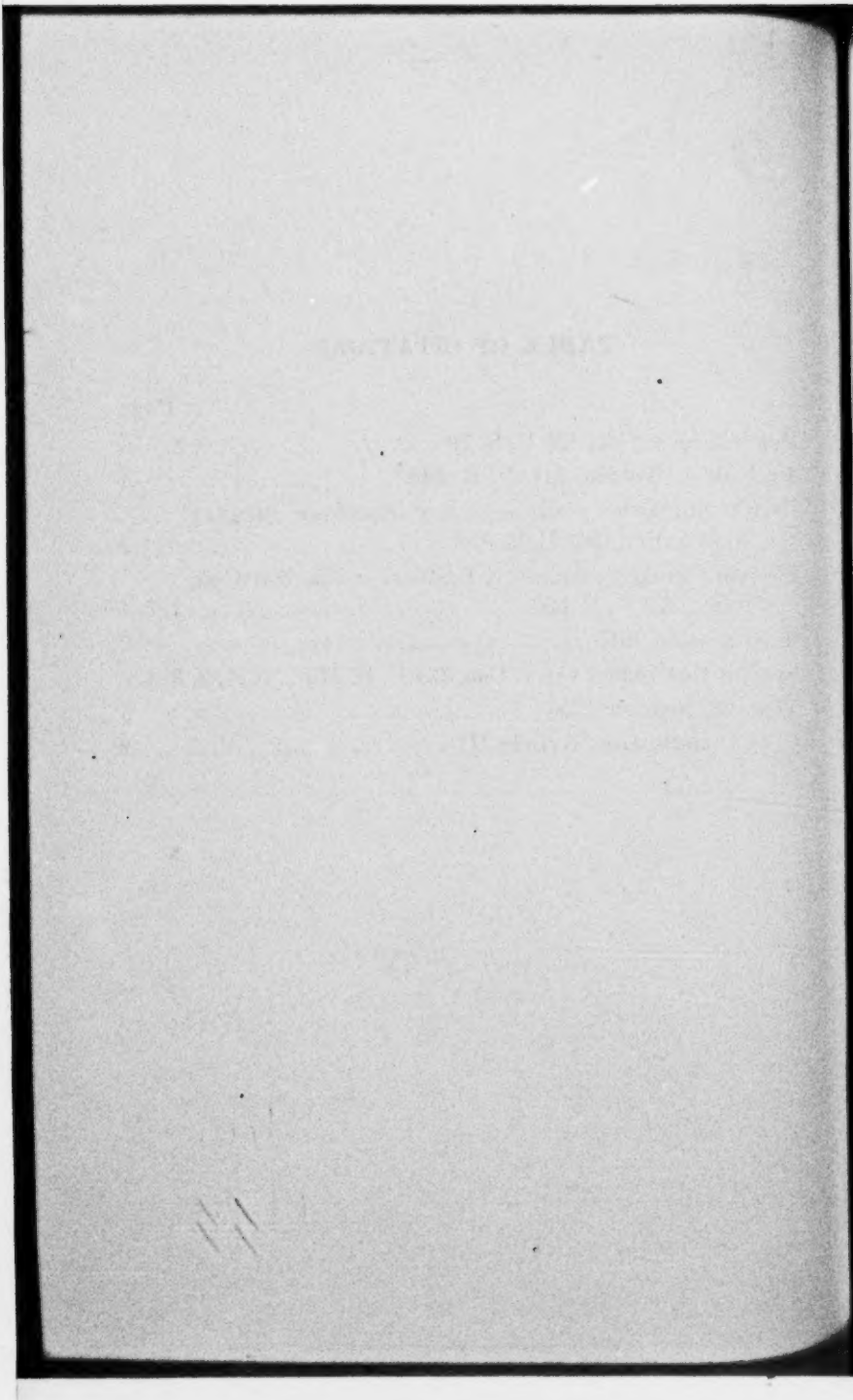

IN THE

Supreme Court of the United States.

No. 300.

October Term, 1954.

HARRIS S. CAMPBELL,
Petitioner,

v.

COMMISSIONER OF PATENTS,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

REPLY BRIEF FOR PETITIONER.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent's Brief in opposition to the Petition for Certiorari presents solely the question whether this Court has jurisdiction to review the judgment of the court below. In support of its position that this Court lacks jurisdiction, Respondent relies principally, if not entirely, on *Postum Cereal Company v. California Fig Nut Company*, 272 U. S. 693. If that case is to be taken as holding that the judgment here sought to be reviewed is a mere administrative judgment and not a judicial judgment, it is respectfully submitted that the *Postum* case has by implication, at least, been overruled by two cases in this Court.

We refer to the cases of *Special Equipment Co. v. Coe*, 324 U. S. 370 and *Hoover Co. v. Coe*, 325 U. S. 79. In both

of these cases this Court granted Petitions for Certiorari to review judgments arising in proceedings under R. S. Section 4915, stemming from the Patent Office.

In the *Special Equipment Company* case, the Court said:

> "This is a suit in equity, brought in the District Court of the District of Columbia, under R.S. § 4915, 35 U.S.C.A. § 63, to compel respondent, the Commissioner of Patents, to issue a patent upon an application for a subcombination of the elements of a machine for which the inventor had previously filed a patent application." (324 U.S. 371)

In the *Hoover Company* case, the question presented was as follows:

> "The question presented is whether a District Court has jurisdiction of a suit under R.S. § 4915 to review the refusal of a claim for patent as not reading on the application. The court below answered in the negative." (325 U.S. 80)

In both the *Special Equipment* and *Hoover* cases and the instant case, the issue presented was the same, namely, a review of a determination by the Commissioner of Patents refusing the respective applicants the patents sought. On that issue the only distinction that can be said to exist between those two cases and the instant case is that in the *Special Equipment* and *Hoover* cases the review below was sought by the instituting of a suit in the District Court for the District of Columbia, whereas in the instant case the review was sought by the alternative method set forth in the Statute, permitting appeal to the Court of Customs and Patent Appeals.

If the situation presented in the *Special Equipment* and *Hoover* cases were a "case" within the meaning of Article III of the Constitution sufficient to justify this Court granting Certiorari, the issue in the instant case must be of identical nature. If a case or controversy arose

in the *Special Equipment* and *Hoover* cases over the refusal of the Commissioner of Patents to grant a patent, then it would seem too clear for argument that the nature of these proceedings in which your Petitioner was refused a patent presents the same type of case or controversy. Certainly the fact that a party takes one alternative remedy for a review afforded by a Statute rather than the other can in no manner determine "the nature of the proceedings".

The Court, in the *Hoover* case, after considering the legislative history of statutes dealing with review of Patent Office decisions, said (325 U.S. at page 87):

> "Thus it is clear that throughout more than a century Congress has for correction of erroneous adverse rulings, which if unreversed would end the proceedings in the Patent Office, preserved the remedy by bill in a district court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal."

An additional and cogent reason for granting the Writ in this case (apparently not present in the *Special Equipment* and *Hoover* cases) is the fact that here the court below, acting in its judicial capacity, failed to give effect to the direct statutory mandate that "the provisions of this title relating to patents for inventions shall apply to patents for designs" etc., thus finally depriving petitioner of his right to a patent.*

In addition to Respondent's reliance on the *Postum* case, Respondent relies on quite a number of cases (set forth in footnote 7 on page five of Respondent's Brief) wherein this Court denied Certiorari without comment; and the inference is attempted to be drawn that such denial was on jurisdictional basis.

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* Respondent admits (Brief p. 3),

"Thus if the division [of petitioner's design patent application from his mechanical patent application] was proper, the illustration from 'American Helicopter' could not be a bar".

In footnote 8 on page seven of Respondent's Brief, the inference is made more plain, in that it is stated that jurisdictional grounds alone were pressed as reasons for opposing the Petitions for Certiorari in the cases there referred to. No reasons being given by this Court for the denial of Certiorari in the cases referred to in footnotes 7 and 8 mentioned above, we respectfully submit that it cannot be contended, inferred or assumed that the reasons for the denials of the writs were jurisdictional.

On page five of Respondent's Brief the statement is made that this Court continues to refuse to assume jurisdiction over summary appeals in both patent and trade mark cases. Two cases are cited in support of this statement. They are:

Pacific Northwest Canning Co. v. Skookum Packers' Association, 283 U. S. 858;
McBride v. Teeple, 311 U. S. 649.

It is to be noted in the *Pacific Northwest* case the sole authority relied on is the *Postum Cereal* case above referred to, and in the *McBride* case the *Postum Cereal* case was likewise strongly relied on.

It is important to note, however, that the denial of Certiorari in the two cases above referred to was prior to the granting of Certiorari by this Court in the *Special Equipment* and *Hoover* cases.

We respectfully submit that by the granting of the Petitions in the *Special Equipment* and *Hoover cases*, this Court has, by implication at least, refused to follow the holding in the *Postum Cereal* case.

To argue whether the Court of Customs and Patent Appeals is a judicial agency placed for convenience of housekeeping in the Executive Branch of the Government is merely a matter of legal semantics. Whatever it may be called, it is an independent judicial agency, the work of which is not subject to supervision and review by the Executive Branch of the Government but only by Federal Courts.

Commencing at page six of Respondent's Brief, the argument is made that Section 1256 of Title 28 is an unlawful attempt on the part of Congress to extend the jurisdiction of this Court. The whole postulate for this argument is that prior to the codification of Title 28 U.S.C. in 1948, this Court lacked constitutional power to review patent and trade mark cases. This entire argument of necessity fails when it is viewed in light of the *Special Equipment* and *Hoover* cases above referred to.

Conclusion.

It is respectfully submitted that this Court should not deny Certiorari on the ground of lack of jurisdiction, but, on the contrary, that the Petition for Certiorari should be granted, particularly where, as here, Respondent admits that the question raised by the decision below was one of "first impression" and an "important" one (Respondent's Brief, foot of page 3).

Respectfully submitted,

EDWARD H. DAVIS,
Counsel for Petitioner.

October 5, 1954.